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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/081,872	05/20/1998	JOHN H. MESSING		2041

7590

06/20/2002

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TUCSON, AZ 85712

EXAMINER
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MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/081,872

Applicant(s)

MESSING, JOHN H.

Examiner

Douglas J. Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 56-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-62 and 64-75 is/are rejected.
- 7) ☒ Claim(s) 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 19.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 01 April 2002 that cancelled claims 36-55, added claims 56-70, and amended the specification.

### ***Response to Arguments***

2. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The nine elements described by applicant as differentiating Kocher from the instant invention are all additions to Kocher and do not preclude Kocher from meeting the limitations of the claims. Applicant opines that Kocher does not show signing of the document, but rather just of the timestamp. Signing the timestamp requires inclusion of the document, which covers signing the document.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., boilerplate information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has attempted to challenge the examiner's taking of Official Notice; however, applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. MPEP 2144.03 Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The examiner's taking of Official Notice has been maintained.

In an interview on 10 June 2002, Applicant indicated that the preferred embodiment of the invention involved, as the examiner understood it, a collection of parties share use of a public key pair. Documents are sent to a server, which signs the documents, first with the private key, and then with a symmetric key based on the sender's identity. Thus, the signature is bound to a specific entity, but also signed in a way that can be verified by anybody holding the public key. The examiner is not sure though, what benefit is accrued from the private key signing. Haven't the benefits stemming from the public key signing should already been realized through the symmetric key signing?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 56, 57, 59-62, 64, 68-73 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Kocher (6188766).

Lines 26-37 of column 7 disclose many identifiers of a sending entity, some of which are explicitly sent to a timestamping archive. The archive corresponds to applicant's server system, the sending entity to applicant's client. Element 210 of figure 2 is the reception of a document from the client at the archive. This would necessitate the establishment of a document and the intent of the client to send the document to the archive.

Element 220 of figure 2 shows the archive authorizing the sender. Element 230 timestamps the document. In lines 38-45 of column 10, Kocher expands on this, saying that the timestamping might include signing. Incidentally, the identifier is also signed since it is potentially part of the document sent to the archive.

Kocher teaches TTIs in lines 48-52 of column 3, which read on unique identifiers. In lines 39-40 of column 7, Kocher mentions network addresses as identifiers. Figure 3 anticipates claim 72: clause 1 of the claim is inherent from element 310; clause 2 is a result of the reception of the DIV in element 300; clause 3 is shown by element 340. Line 35 of column 7 mentions credit card numbers. The phrase "electronic process" is broad enough to include the client's computer. In line 30 of column 7, a client authenticates itself through knowledge of a dedicated phone line number.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that client actions are carried out as a result of voice commands. Official notice is taken that it is old and well known to effectuate actions through voice commands. Voice commands are convenient. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to effectuate the indication to sign via voice commands because it is convenient.

9. Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that the client countersigns the document. Official notice is taken that it is old and well known to countersign documents. This provides a further level of proof of acceptance of the now-countersigned document. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the client to countersign the document that had been signed by the timestamping archive to show an added level of agreement.

10. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that the signature is performed through a symmetric encryption using a key that is derived from the unique document identifier. Please note that in lines 46-47 of column 13, Kocher says that any algorithm may be used in the signature. Official notice is taken that it is old and well known to create symmetric keys based on identifiers. This efficiently assigns keys to entities identified by the identifiers. Official notice is taken that MACs, which are essentially signatures using symmetric keys, are old and well known. These signatures are less computationally complex than public key signatures. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the signature using a keyed MAC, wherein the key was derived from the unique identifier of the document.

11. Claims 58, 65, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. This anticipates clause a. Clause b is anticipated by lines 27-37 of column 7, clause c by element 22 of figure 2. Clauses f and g are anticipated by the TTI and the need for the client to send the document to the archive. Kocher does not say that the documents to be signed are based on templates that are filled out by the client. Official notice is taken that it is old and well known to use templates to collect data. This is especially relevant to e-commerce where credit card information is supplied by filling out a web page. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for Kocher's archive to receive, sign, and

later verify documents that are templates filled out with client-supplied information. This would prove useful for on-line transactions. The limitations of claim 36 are met for the same reasons.

In one embodiment, Kocher's documents are formatted, as can be seen in element 210 of figure 2. Templates that include legal disclaimers are known in the realm of templates.

***Allowable Subject Matter***

12. Claim 63 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

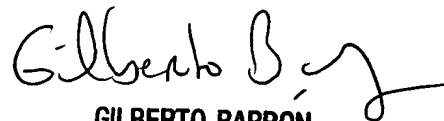
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



DJM

June 17, 2002

Douglas J. Meislahn  
Examiner  
Art Unit 2132



GILBERTO BARRON  
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